

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Invention II”, deemed drawn to a method of diagnostic imaging, and corresponding to claims 25-40.

REMARKS

The Examiner has identified four “inventions” in the pending claims. The Examiner’s classification of the ‘inventions’ include Group I consisting of claims 1-24 and drawn to a method of diagnostic imaging and classified by the Examiner in class 600, subclass 300, Group II consisting of claims 25-40 and drawn to a radiation imaging system and classified by the Examiner in class 378, subclass 64, Group III consisting of claims 41-48 and drawn to a computer readable storage medium and classified by the Examiner in class 713, subclass 1, and Group IV consisting of claims 49-55 and drawn to a filter apparatus to filter radiation and classified by the Examiner in class 378, subclass 156.

In response to the Restriction Requirement imposed by the Examiner, Applicant has elected to cancel claims 49-55, deemed drawn to the filter apparatus of Invention IV.

Applicant has also elected to amend claim 26 to further clarify what is being called for therein. As amended, claim 26 calls for a radiation emitting imaging system of claim 25 wherein a computer is programmed to modulate a variable attenuation profile of a radiation filter during radiation projection toward a subject and acquire imaging data of the subject and reconstruct at least one image therefrom. As explained in greater detail below, Applicant believes that this amendment renders moot the basis for one of the Examiner’s imposed restrictions.

In regards to the substance of the Restriction Requirement, it should be noted that the Examiner has set forth contradictory bases for restriction. That is, initially the Examiner asserted that “Inventions I, II, III, and IV are unrelated” and that “[i]n the instant case, the different inventions are not capable of use together and they have different modes of operation, and effects.” *Office Action*, July 23, 2007, p. 2. (emphasis added) However, immediately thereafter, and in comparing Inventions II and III and Inventions II and IV, the Examiner stated that (in each instance) the Inventions “are related as combination and subcombination.” *Office Action*, supra at 2-3. (emphasis added) The Examiner cannot in one instance assert that there are four unrelated “inventions” in the present claims and then also, as a basis for restriction, state the several of

those “inventions” are related as combination and subcombination. Such a basis for restriction is illogical.

Regardless of the contradictory nature of the Examiner’s bases for restriction, Applicant believes that the Examiner has failed to meet the requirements set forth in the MPEP for imposing a restriction. As described above, the Examiner stated that “Inventions I, II, III, and IV are unrelated” and that “[i]n the instant case, the different inventions are not capable of use together and they have different modes of operation, and effects.” *Office Action*, supra at 2. As set forth in MPEP 806.06, “[i]nventions as claimed are independent if... they are unconnected in design, operation, and effect... and if there would be a serious burden on the examiner if restriction is not required.” MPEP 808.01 goes on to state that “[t]he particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated” and that “[a] mere statement of conclusion is inadequate.” MPEP 808.01 further states that “[e]ach relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth.” Applicant believes that the Examiner has failed to set forth the relationship between the claimed “inventions” and the reasons for the conclusions of distinctness or independence between those “inventions.”

The Examiner asserted that Invention I is unrelated to Inventions II and III, as being drawn to a method of diagnostic imaging. In making the assertion that Invention I is unrelated, however, the Examiner has failed to meet the burden set forth by MPEP 808.01 in showing that the invention is independent or distinct. That is, the Examiner has failed to set forth any reasons as to why Invention I is not disclosed as capable of use with any of the other of Inventions II and III, or why Invention I is different in design, mode of operation, and effect from the other supposed inventions. MPEP 808.01 requires that “[e]ach relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth.” As the Examiner has merely set forth statements of conclusion that the “inventions” are independent/distinct, and not set forth any reasons for these conclusions, the Examiner has failed to meet the burden under MPEP 808.01 in setting forth a basis for restriction. Applicant therefore believes that the restriction between Invention I and Inventions II & III as being unrelated is deficient and must be withdrawn.

The Examiner also imposed a restriction between Inventions II and III as being related as combination and subcombination under MPEP §806.05(c), which states that “inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and nonobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination”. The Examiner asserted that, “[i]n the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not specifically require a computer for acquiring imaging data and reconstruct[ing] an image therefrom having the specific features and functionality recited in the subcombination claims” and that “the subcombination has separate utility such as a set of computer executable instructions for processing x-ray image data by a CT scanner.” *Office Action*, supra at 3.

Applicant believes that the amendment to claim 26, set forth above, renders the Examiner’s basis for restriction between Inventions II and III moot. That is, claim 26 calls for a radiation emitting imaging system wherein a computer is programmed to modulate a variable attenuation profile of a radiation filter during radiation projection toward a subject and acquire imaging data of the subject and reconstruct at least one image therefrom. As the acquisition and reconstruction of image data by the computer was the only “particular of the subcombination” identified by the Examiner as lacking in the combination, and as it is now called for in claim 26, Applicant believes that Examiner’s reasons for imposing the restriction between Inventions II and III is now moot.

The Examiner also asserted that the subcombination of Invention III has a separate utility from Invention II such as a set of computer executable instructions for processing x-ray image data by a CT scanner. Similar to above, Applicant believes that claim 26 renders this assertion by the Examiner moot. That is, claim 26 calls for a computer configured to analyze and reconstruct image data, and thus the combination includes this utility that was also claimed in the subcombination. As the Examiner has not shown the subcombination to have any other utility, either by itself or in another materially different combination, Applicant believes that the restriction between Inventions II and III should be withdrawn.

Because the Examiner has thus failed to show how the combination as claimed does not require the particulars of the subcombination as required and how the subcombination has a

separate utility from the combination, Applicant believes that the Examiner has not met the burden to show distinctness between the combination and subcombination as required in MPEP §806.05(c). Accordingly, the restriction requirement between Inventions II and III is believed improper and Applicant requests withdrawal thereof.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of Inventions I, II, and III. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin
Registration No. 55,584
Phone 262-268-8100 ext. 15
krr@zpspatents.com

Dated: August 23, 2007
Attorney Docket No.: GEMS8081.115

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100

General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-0845. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-0845. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 07-0845. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 07-0845.

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-268-8181
tjz@zpspatents.com

Dated: August 23, 2007
Attorney Docket No.: GEMS8081.115

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100